

This misses Applicant's reason for traversal. *Applicant has never asserted that there is no suggestion to combine the references.*

Rather, Applicant has shown that none of the cited references or combination of the references disclose or suggest the limitations set out in the claims. That is, there are limitations set out in the claims that are not disclosed or suggested by either of the references and thus not disclosed or suggested by any combination of the references.

The U.S. Patent and Trademark Office has set forth a methodology for establishing a *prima facie* case of obviousness. The third criteria states that "the prior art reference (or references when combined) must teach or suggest all the claim limitations."

In this case, the references, whether considered alone or in combination, do not teach or suggest all the claim limitations. Below, Applicant particularly points out for each independent claim which limitations are not disclosed or suggested by any of the cited references, whether considered alone or in combination.

Examiner has also asserted the following:

In response to applicant's argument on pages 8-11 against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references.

See the Office Action dated July 14, 2003 (Paper Number 4) at page 4, lines 16 through 18.

Again, this misses Applicant's reason for traversal. Applicant is not attacking the references individually. Rather, Applicant has shown that none of the cited references or combination of the references disclose or suggest the

limitations set out in the claims. That is, there are limitations set out in the claims that are not disclosed or suggested by either of the references and thus not disclosed or suggested by any combination of the references.

The U.S. Patent and Trademark Office has set forth a methodology for establishing a *prima facie* case of obviousness. The third criteria states that “the prior art reference (or references when combined) must teach or suggest all the claim limitations.”

In this case, the references, whether considered alone or in combination, do not teach or suggest all the claim references. Below, Applicant particularly points out for each independent claim which limitations are not disclosed or suggested by any of the cited references, whether considered alone or in combination.

#### **Claim Rejections - 35 U.S.C. § 103**

Examiner has rejected claims 1 through 20 under 35 U.S.C. § 103(a) as being unpatentable over USPN 5,724,595 (Gentner) in view of USPN 6,008,811 (McMillan). Applicant respectfully traverses the rejection and requests reconsideration.

#### **Criteria for a Rejection under 35 U.S.C. § 103(a)**

The U.S. Patent and Trademark Office has set forth a methodology for establishing a *prima facie* case of obviousness. Specifically, three basic criteria must be met.

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

See MPEP 706.02 (j).

Applicant believes Examiner has failed to establish a *prima facie* case of obviousness because none of the cited references discloses or suggests the limitations set out in the claims.

Below, Applicant discusses limitations in each claim which are not disclosed or suggested by Gentner, McMillan or a combination of Gentner and McMillan. On the basis of this, Applicant believes the Examiner has failed to establish a *prima facie* case of obviousness. Since there is no *prima facie* case of obviousness, Applicant believes all the claims in the case should be allowable.

### **Discussion of Independent Claim 1**

Claim 1 sets out a method for printing a URL page by a computing system. This is subject matter not disclosed or suggested by Gentner or McMillan.

McMillan does not discuss the internet, web pages or URLs and so is not concerned with printing a URL page.

Gentner discusses creating hypertext links. However, Gentner is not concerned with printing out URL pages.

Since neither McMillen nor Gentner disclose or suggest printing out URL pages, no combination of McMillen and Gentner will disclose or suggest printing out URL pages. Printing out URL pages is subject matter disclosed by the present application and not by any combination of McMillen and Gentner.

Step (a) of claim 1, indicates a reference to a URL address is dragged and dropped upon a print icon. This subject matter is not disclosed or suggested by Gentner or McMillan.

McMillan does not discuss the internet, web pages or URLs.

Gentner discusses creating hypertext links. However, the links are to target documents. Gentner does not disclose or suggest dropping a URL address on a print icon.

Since neither McMillen nor Gentner disclose or suggest dropping a URL address on a print icon, no combination of McMillen and Gentner will disclose or suggest dropping a URL address on a print icon. Dropping a URL address on a print icon is subject matter disclosed by the present application and not by any combination of McMillen or Gentner.

In step (a.1) the URL page is accessed from an Internet network. This subject matter is not disclosed or suggested by Gentner or McMillan.

McMillan does not discuss the internet, web pages or URLs.

In Gentner, during a drag and drop operation *the URL page is never accessed*. In Gentner, as the result of a drag and drop operation, the *title* of the target page is inserted into the text of the original page at the location of the mouse pointer and the title of the target page is underlined and shown in a

special color (normally blue) to indicate that it is a hypertext link. See column 3, lines 43 through 55. However, Gentner does not access the URL page itself.

Since neither McMillen nor Gentner disclose or suggest accessing a URL page during a drag and drop operation, no combination of McMillen and Gentner will disclose or suggest accessing a URL page during a drag and drop operation. Accessing a URL page during a drag and drop operation is subject matter disclosed by the present application and not by any combination of McMillen or Gentner.

In substep (a.2) the URL page is printed on a printer. Substep (a.1) and substep (a.2) are performed without displaying the URL page to a user of the computing system. This subject matter is not disclosed or suggested by Gentner or McMillan.

McMillan does not discuss the internet, web pages or URLs.

In Gentner, is not concerned with printing out URL pages.

Since neither McMillen nor Gentner disclose or suggest printing out URL pages, no combination of McMillen and Gentner will disclose or suggest printing out URL pages. Printing out URL pages is subject matter disclosed by the present application and not by any combination of McMillen and Gentner.

The chart below summarizes the limitations of independent claim 1 not found in McMillan or Gentner.

Subject matter in claim 1	Gentner	McMillan
Preamble: Printing a URL page	Does not disclose printing a URL page	Does not disclose printing a URL page
Step (a): Drag and drop a URL address upon a print icon	Does not disclose drag and drop of a URL address upon a print icon	Does not disclose drag and drop of a URL address upon a print icon
Substep (a.1): Accessing a URL page when a drag and drop is performed	Gentner does not access the URL page upon a drag and drop into a document	McMillan does not discuss accessing a URL page
Substep (a.2): Printing a URL page on a printer	Does not disclose printing a URL page on a printer	Does not disclose printing a URL page on a printer

Essentially none of the pertinent subject matter of claim 1 is disclosed or suggested by Gentner or McMillan. While these references describe some form of drop and drag functionality, neither of these references address any of the issues involved in printing a URL page nor does either reference address what is necessary to implement a drag and drop feature of a URL address over a print icon.

Since none of the disclosed limitations of claim 1 are disclosed in either Gentner or McMillan, it is clear that any combination of Gentner and McMillan will not contain these limitations. These limitations are only disclosed through Applicant's disclosure and not from McMillen, Gentner or any combination of McMillen and Gentner.

Applicant believes it is clear that Examiner has failed to establish a *prima facie* case of obviousness. That is Examiner has failed to satisfy the third criteria for establishing a *prima facie* case of obviousness that states: "the prior art reference (or references when combined) must teach or suggest all the claim limitations."

### **Discussion of Independent Claim 8**

Claim 8 sets out a method for printing a URL page by a computing system. This is subject matter not disclosed or suggested by Gentner or McMillan.

McMillan does not discuss the internet, web pages or URLs and so is not concerned with printing a URL page.

Gentner discusses creating hypertext links. However, Gentner is not concerned with printing out URL pages.

Since neither McMillan nor Gentner disclose or suggest printing out URL pages, no combination of McMillan and Gentner will disclose or suggest printing out URL pages. Printing out URL pages is subject matter disclosed by the present application and not by any combination of McMillan and Gentner.

Step (a) of claim 8 indicates a reference to a URL address is dragged and dropped upon a desktop for the computing system. This subject matter is not disclosed or suggested by Gentner or McMillan.

McMillan does not discuss the internet, web pages or URLs.

Gentner discusses creating hypertext links. However, the links are to target documents. Gentner does not disclose or suggest dropping a URL address upon a desktop.

Since neither McMillan nor Gentner disclose or suggest dropping a URL address on a desktop, no combination of McMillan and Gentner will disclose or dropping a URL address on a desktop. Dropping a URL address

on a desktop is subject matter disclosed by the present application and not by any combination of McMillen or Gentner.

In step (a.1) A special icon representing the URL page address is created on the desktop. This subject matter is not disclosed or suggested by Gentner or McMillan.

McMillan does not discuss the internet, web pages or URLs.

In Gentner, during a drag and drop operation *the URL page is never accessed*. In Gentner, as the result of a drag and drop operation, the *title* of the target page is inserted into the text of the original page at the location of the mouse pointer and the title of the target page is underlined and shown in a special color (normally blue) to indicate that it is a hypertext link. See column 3, lines 43 through 55. Gentner does not disclose or suggest creating a special icon on the desktop.

Since neither McMillen nor Gentner disclose or suggest creating a special icon on the desktop, no combination of McMillen and Gentner will disclose or suggest creating a special icon on the desktop. Creating a special icon on the desktop is subject matter disclosed by the present application and not by any combination of McMillen or Gentner.

In step (b), upon a user performing a function to activate the special icon, the URL page is printed. McMillan does not disclose or suggest printing URL pages. Gentner likewise does not disclose or suggest printing out URL pages.

Since neither McMillen nor Gentner disclose or suggest printing out URL pages, no combination of McMillen and Gentner will disclose or suggest



printing out URL pages. Printing out URL pages is subject matter disclosed by the present application and not by any combination of McMillen and Gentner.

Since the limitations of claim 8 are not disclosed in either Gentner or McMillan, it is clear that any combination of Gentner and McMillan will not contain these limitations. These limitations are only disclosed through Applicant's disclosure and not from McMillen, Gentner or any combination of McMillen and Gentner.

Applicant believes it is clear that Examiner has failed to establish a *prima facie* case of obviousness. That is Examiner has failed to satisfy the third criteria for establishing a *prima facie* case of obviousness that states: "the prior art reference (or references when combined) must teach or suggest all the claim limitations."

#### **Discussion of Independent Claim 16**

Claim 16 sets out computer readable medium containing software, which when executed performs a method for printing a URL page by a computing system. This is subject matter not disclosed or suggested by Gentner or McMillan.

McMillan does not discuss the internet, web pages or URLs and so is not concerned with printing a URL page.

Gentner discusses creating hypertext links. However, Gentner is not concerned with printing out URL pages.

Since neither McMillen nor Gentner disclose or suggest printing out URL pages, no combination of McMillen and Gentner will disclose or suggest printing out URL pages. Printing out URL pages is subject matter disclosed by the present application and not by any combination of McMillen and Gentner.

Step (a) of claim 16 indicates a reference to a URL address is dragged and dropped upon a print icon. This subject matter is not disclosed or suggested by Gentner or McMillan.

McMillan does not discuss the internet, web pages or URLs.

Gentner discusses creating hypertext links. However, the links are to target documents. Gentner does not disclose or suggest dropping a URL address on a print icon.

Since neither McMillen nor Gentner disclose or suggest dropping a URL address on a print icon, no combination of McMillen and Gentner will disclose or suggest dropping a URL address on a print icon. Dropping a URL address on a print icon is subject matter disclosed by the present application and not by any combination of McMillen or Gentner.

In step (a.1) the URL page is accessed from an Internet network. This subject matter is not disclosed or suggested by Gentner or McMillan.

McMillan does not discuss the internet, web pages or URLs.

In Gentner, during a drag and drop operation *the URL page is never accessed*. In Gentner, as the result of a drag and drop operation, the *title* of the target page is inserted into the text of the original page at the location of the mouse pointer and the title of the target page is underlined and shown in a

special color (normally blue) to indicate that it is a hypertext link. See column 3, lines 43 through 55. However, Gentner does not access the URL page itself.

Since neither McMillen nor Gentner disclose or suggest accessing a URL page during a drag and drop operation, no combination of McMillen and Gentner will disclose or suggest accessing a URL page during a drag and drop operation. Accessing a URL page during a drag and drop operation is subject matter disclosed by the present application and not by any combination of McMillen or Gentner.

In substep (a.2) the URL page is printed on a printer. Substep (a.1) and substep (a.2) are performed without displaying the URL page to a user of the computing system. This subject matter is not disclosed or suggested by Gentner or McMillan.

McMillan does not discuss the internet, web pages or URLs.

In Gentner, is not concerned with printing out URL pages.

Since neither McMillen nor Gentner disclose or suggest printing out URL pages, no combination of McMillen and Gentner will disclose or suggest printing out URL pages. Printing out URL pages is subject matter disclosed by the present application and not by any combination of McMillen and Gentner.

Essentially none of the pertinent subject matter of claim 16 is disclosed or suggested by Gentner or McMillan. While these references describe some form of drop and drag functionality, neither of these references address any of the issues involved in printing a URL page nor does either reference

address what is necessary to implement a drag and drop feature of a URL address over a print icon.

Since none of the disclosed limitations of claim 16 are disclosed in either Gentner or McMillan, it is clear that any combination of Gentner and McMillan will not contain these limitations. These limitations are only disclosed through Applicant's disclosure and not from McMillen, Gentner or any combination of McMillen and Gentner.

Applicant believes it is clear that Examiner has failed to establish a *prima facie* case of obviousness. That is Examiner has failed to satisfy the third criteria for establishing a *prima facie* case of obviousness that states: "the prior art reference (or references when combined) must teach or suggest all the claim limitations."

#### **Discussion of Independent Claim 19**

Claim 19 sets out computer readable medium containing software, which when executed performs a method for printing a URL page by a computing system. This is subject matter not disclosed or suggested by Gentner or McMillan.

McMillan does not discuss the internet, web pages or URLs and so is not concerned with printing a URL page.

Gentner discusses creating hypertext links. However, Gentner is not concerned with printing out URL pages.

Since neither McMillen nor Gentner disclose or suggest printing out URL pages, no combination of McMillen and Gentner will disclose or suggest

printing out URL pages. Printing out URL pages is subject matter disclosed by the present application and not by any combination of McMillen and Gentner.

In step (a) of claim 19 indicates a reference to a URL address is dragged and dropped upon a desktop for the computing system. This subject matter is not disclosed or suggested by Gentner or McMillan.

McMillan does not discuss the internet, web pages or URLs.

Gentner discusses creating hypertext links. However, the links are to target documents. Gentner does not disclose or suggest dropping a URL address upon a desktop.

Since neither McMillen nor Gentner disclose or suggest dropping a URL address on a desktop, no combination of McMillen and Gentner will disclose or dropping a URL address on a desktop. Dropping a URL address on a desktop is subject matter disclosed by the present application and not by any combination of McMillen or Gentner.

In step (a.1) A special icon representing the URL page address is created on the desktop . This subject matter is not disclosed or suggested by Gentner or McMillan.

McMillan does not discuss the internet, web pages or URLs.

In Gentner, during a drag and drop operation *the URL page is never accessed*. In Gentner, as the result of a drag and drop operation, the *title* of the target page is inserted into the text of the original page at the location of the mouse pointer and the title of the target page is underlined and shown in a special color (normally blue) to indicate that it is a hypertext link. See

column 3, lines 43 through 55. Gentner does not disclose or suggest creating a special icon on the desktop.

Since neither McMillen nor Gentner disclose or suggest creating a special icon on the desktop, no combination of McMillen and Gentner will disclose or suggest creating a special icon on the desktop. Creating a special icon on the desktop is subject matter disclosed by the present application and not by any combination of McMillen or Gentner.

In step (b), upon a user performing a function to activate the special icon, the URL page is printed. McMillan does not disclose or suggest printing URL pages. Gentner likewise does not disclose or suggest printing out URL pages.

Since neither McMillen nor Gentner disclose or suggest printing out URL pages, no combination of McMillen and Gentner will disclose or suggest printing out URL pages. Printing out URL pages is subject matter disclosed by the present application and not by any combination of McMillen and Gentner.

Since the limitations of claim 19 are not disclosed in either Gentner or McMillan, it is clear that any combination of Gentner and McMillan will not contain these limitations. These limitations are only disclosed through Applicant's disclosure and not from McMillen, Gentner or any combination of McMillen and Gentner.

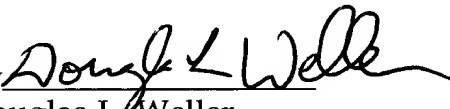
Applicant believes it is clear that Examiner has failed to establish a *prima facie* case of obviousness. That is Examiner has failed to satisfy the third criteria for establishing a *prima facie* case of obviousness that states: "the prior

art reference (or references when combined) must teach or suggest all the claim limitations."

**Conclusion**

Applicant believes that the present Application is in condition for allowance and favorable action is respectfully requested.

Respectfully submitted,  
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